

Appl. No. : 10/042,775  
Filed : January 8, 2002

### REMARKS

The Applicants have amended Claims 1, 2, 10, 14, 17, and 18, cancelled Claims 4, 8, and 20, and added Claims 23-27. Thus, Claims 1-3, 5-7, 9-19, and 21-27 are presented for examination. The Applicants thank the Examiner for allowing Claims 3, 5, 7-11, 14-16, 18, and 20. The specific changes to the amended claims are shown above in the Amendments to the Claims, wherein the insertions are underlined and the ~~deletions are stricken through~~. The Applicants respond below to rejections and objections raised by the Examiner in the Office Action of January 2, 2003.

#### I. Oath/Declaration

The Examiner has stated that the declaration is defective for failure to identify the mailing address of each inventor. The Applicants note that a previously submitted declaration by inventor David J. Rawlings contained a residence address, but was blank as to a post office address. Submitted herewith is a replacement declaration by David J. Rawlings. The Applicants respectfully submit that this declaration corrects the deficiency.

#### II. Rejections under 35 U.S.C. § 102

Claims 1, 2, 6, 12, 13, 17, 19, 21, and 22 stand rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by Kastan *et al.* (US 6,387,640). The Applicants respectfully submit that in their amended form, these claims are not anticipated by the prior art of record.

Claim 1 now recites, *inter alia*, "infecting ATM deficient mammalian cells with said viral vector, wherein said mammalian cells are thereby made to produce functional ATM protein . . . ." The Applicants respectfully submit that the additional limitations of Claim 1 are similar to those of allowed Claim 8. Accordingly, Claim 1 is now allowable over the art of record. Further, all claims dependent from Claim 1, namely 2, 3, 5-7, and 9-16, are allowable as well.

Claim 17 now recites, *inter alia*, "isolating said functional ATM protein produced by said mammalian cells by binding an anti-ATM antibody to the ATM protein." The Applicants respectfully submit that the additional limitations of Claim 17 are similar to those of allowed Claim 20. Accordingly, Claim 17 is now allowable for the same reasons. Further, all claims dependent from Claim 17, namely 18, 19, 21, and 22, are allowable as well.

In view of the above, the Applicants respectfully request that the § 102 rejection be withdrawn and the pending claims allowed over the art of record.

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**IV. Rejections under 35 U.S.C. § 112**

Claim 4 stands rejected under 35 U.S.C. § 112 as allegedly containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to make and/or use the invention. The Applicants submit that Claim 4 has been cancelled by the present Amendment and that the § 112 rejection is now moot.

**VI. New Claims 23-27**


New independent Claim 23 recites, *inter alia*, "isolating said functional ATM protein produced by said mammalian cells wherein said functional ATM protein is produced at a level of greater than 2 µg substantially purified ATM protein per 300 grams fresh weight of host cells or host tissue." The Applicants respectfully submit that Claim 23 is similar to allowed Claim 14. Accordingly, Claim 23 is allowable for the same reasons. Further, all claims dependent from Claim 23, namely Claims 24, 25, 26, and 27, are allowable as well.

**CONCLUSION**

The Applicant has endeavored to address all of the Examiner's concerns as expressed in the outstanding Office Action. Accordingly, amendments to the claims, the reasons therefor, and arguments in support of the patentability of the pending claim set are presented above. Any claim amendments which are not specifically discussed in the above remarks are made in order to improve the clarity of claim language, to correct grammatical mistakes or ambiguities, and to otherwise improve the capacity of the claims to particularly and distinctly point out the invention to those of skill in the art. In light of the above amendments and remarks, reconsideration and withdrawal of the outstanding rejections is respectfully requested. If the Examiner has any questions which may be answered by telephone, she is invited to call the undersigned directly.

Respectfully submitted,  
KNOBBE, MARTENS, OLSON & BEAR, LLP

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By:   
Erik T. Anderson  
Registration No. 52,559  
Attorney of Record  
2040 Main Street, Fourteenth Floor  
Irvine, CA 92614  
(619)235-8550